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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,649	08/01/2000	J. Scott Carr	60256	7630
23735	7590	11/30/2004	EXAMINER	
DIGIMARC CORPORATION			COUSO, YON JUNG	
9405 SW GEMINI DRIVE			ART UNIT	
BEAVERTON, OR 97008			PAPER NUMBER	
			2625	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/629,649

**Applicant(s)**

CARR ET AL.

**Examiner**

Yon Couso

**Art Unit**

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

1. In view of the appeal brief filed on August 16, 2004, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6, 8-11, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Leon (US Patent No. 6,701,304).

As for claim 6, Leon teaches an envelope having encoded thereon a fragile digital watermark representing plural bits of digital data (column 2, lines 21-46 and column 7, line 66-column 8, line 22), the watermark being designated to evidence reproduction by scanning and printing (column 10, lines 31-32).

As for claim 8, Leon teaches an envelope having steganographically encoded thereon a digital watermark representing postage (column 2, lines 21-46 and column 7, line 66-column 8, line 22).

As for claim 9, Leon teaches the steganographic encoding takes the form of printing on the envelope (column 7, line 66-column 8, line 2).

As for claim 10, Leon teaches the printing is with an ink designed for sensing in the ultraviolet or infrared spectra (column 9, lines 13-40).

As for claim 11, the encoding takes the form of texturing on the surface of the envelope (column 9, lines 41-52).

As for claim 19, Leon teaches an envelope having formed thereon two machine readable indicia, a first of the indicia being a franking mark applied by a first party (412 and/or 414 in figure 4), the second of the indicia conveying data associated with an authorized user of the envelope (418 in figure 4), the first and second indicia cooperating to confirm that use of the envelope by the first party is authorized (column 12, line 30-column 13, line 53).

3. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Adler et al (US Patent No. 6,275,599).

As for claim 6, Adler teaches an envelope having encoded thereon a fragile digital watermark representing plural bits of digital, the watermark being designated to evidence reproduction by scanning and printing (column 1, lines 23-26; reproduction is considered altering).

4. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Coppersmith et al (US Patent No. 6,256,736).

As for claim 6, Coppersmith teaches an envelope having encoded thereon a fragile digital watermark representing plural bits of digital data, the watermark being designated to evidence reproduction by scanning and printing (column 1, lines 24-30; reproduction is considered modification).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao (US Patent No. 6,754,822) in view of Leon.

As for claims 6 and 7, Zhao teaches a document having encoded thereon a fragile digital watermark representing plural bits of digital data, the watermark being

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designated to evidence reproduction by scanning and printing (column 17, lines 20-24). Zhao also teaches a document having encoded thereon a machine readable indicia that indicates, to suitably equipped devices, that image data corresponding to the envelope should not be reproduced (column 19, lines 48-57).

Even though Zhao does not specify an envelope as one of the document being processed in the system, it is clear to the one of ordinary skill in the art that the document taught in Zhao can be of any document, including envelope. Leon discloses an envelope having encoded thereon a fragile digital watermark representing plural bits of digital data (column 2, lines 21-46 and column 7, line 66-column 8, line 22), the watermark being designated to evidence reproduction by scanning and printing (column 10, lines 31-32). Zhao and Leon are combinable because they are both directed to techniques for protecting the security of digital representations using watermark technology. At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine Zhao with Leon to obtain the invention as specified in the claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Karas (5,717,597 and 6,505,179), Bhaskaran et al, and Bender et al are also cited.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yon Couso whose telephone number is (703) 305-4779. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



YJC

November 19, 2004

**BHAVESH M. MEHTA**  
**SUPERVISORY PATENT EXAMINER**  
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